

REMARKS/ARGUMENTS

Claims 1-21 are pending in this application. Claims 3 and 10 have been currently amended. Claims 1, 8 and 15 are independent claims.

Objection to Specification

Please amend the title of the invention to “METHODS FOR PROGRAMMING USB HUB WITH INPUT PIN.”

The Patent Office has alleged that the specification “is non-enabling for claims 1, 6, 8, 13, 15, 20” (Office Action, page 2, the second line from the bottom) for “failing to teach or suggest programming the USB hub with actual port value wherein the programming comprising selecting the actual port value by an Input Pin (claims 1, 8, 15); wherein the universal serial bus (USB) hub is programmed over an external bus (claims 6, 13, 20)” (Office Action, page 2). Applicant respectfully disagrees. As clearly indicated in the Specification, the number of ports supported by a USB hub are set up through an external hardware change, such as by selecting the number of ports by an Input Pin (emphasis added) (page 9, paragraph [0026]), and “[i]t may be desirable to enable the internal settings to be accessed by an external bus, such as the universal serial bus itself” (emphasis added) (page 10, paragraph [0027]). Further, Applicant respectfully submits that “selecting the number of ports by an Input Pin” is well-known. Therefore, Applicant respectfully submits that the Specification supports, teaches and enables Claims 1, 6, 8, 13, 15 and 20.

Claim Rejections – 35 USC § 112

Applicant has currently amended Claims 3 and 10 for clarification.

Claims 1-21 were rejected under 35 USC § 112, first paragraph, for the reasons set forth in the objection to the specification (Office Action, page 3). However, based on the reasons set forth in the foregoing *Objection to Specification* section, this rejection should be withdrawn.

Claim Rejections – 35 USC § 103(a)

Claims 1, 3-8, 10-15 and 17-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunn et al. (“Dunn”, U.S. Pat. No. 6,735,720 – It was admitted by the Examiner Raymond Ngan Phan during a phone conversation on

October 26, 2004 that the correct Patent No. for Dunn is 6,735,720, not 6,475,720 as recited on page 3 of the pending Office Action) in view of Krithivas et al. ("Krithivas", U.S. Pat. No. 6,067,628). Applicant respectfully traverses this rejection.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." (emphasis added) (MPEP § 2143). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. (emphasis added) *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

In rejecting Claim 1, the Patent Office first admitted that the element of "programming the universal serial bus (USB) hub with an actual port value, wherein the actual port value corresponds to the actual number of ports included on the information handling system, said programming comprising selecting the actual port value by an Input Pin" recited in Claim 1 was not specifically disclosed by Dunn (Office Action, page 4, lines 5-9). Then the Patent Office went on to allege that col. 5, line 31 through col. 6, line 44 of Krithivas taught the foregoing element (Office Action, page 4, lines 9-13). Applicant respectfully disagrees.

Col. 5, line 31 through col. 6, line 44 of Krithivas "shows one embodiment of a state machine diagram for detecting an overcurrent event in a USB system" (emphasis added) (col. 4, lines 65-66) and fails to teach, disclose, or suggest "wherein the actual port value corresponds to the actual number of ports included on the information handling system" or "selecting the actual port value by an Input Pin," as recited in Claim 1. Applicant herein respectfully requests the Patent Office to pinpoint exactly where in Col. 5, line 31 through col. 6, line 44 of Krithivas was the element of "programming the universal serial bus (USB) hub with an actual port value, wherein the actual port value corresponds to the actual number of ports included on the information handling system, said programming comprising selecting the actual port value by an Input Pin," as recited in Claim 1, taught, disclosed or suggested.

At least based on the foregoing described reasons, the Patent Office has failed

to establish a *prima facie* case of obviousness for Claim 1. Therefore, the rejection should be withdrawn, and Claims 1 should be allowed.

Claims 2-7 depend from Claim 1 and are therefore nonobvious due to their dependence upon Claim 1. Thus, the rejection should be withdrawn, and Claims 2-7 should be allowed.

Claims 8 and 15 were rejected essentially based on the same reasons as applied to Claim 1. Since Claim 1 is allowable, Claims 8 and 15 are also allowable.

Claims 9-14 and 16-21 depend from Claims 8 and 15, respectfully, and are therefore allowable due to their dependence.

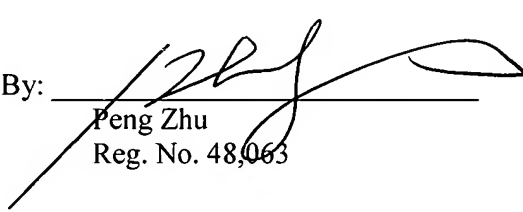
CONCLUSION

In light of the foregoing, Applicant respectfully requests that a timely Notice of Allowance be issued in the case.

Respectfully submitted on behalf of
Gateway, Inc.,

Dated: November 18, 2004

By: _____


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